



29 SEP 2005

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Levine & Mandelbaum
444 Madison Avenue
35th Floor
New York, NY 10022

In re Application of
Carrez et al.
Application No.: 10/519,926
PCT No.: PCT/FR03/03410
Int. Filing Date: 18 November 2003
Priority Date: 20 November 2002
Attorney Docket No.: MART0850US
For: Device For Locoregional Anesthesia And Method
For Making The Cannula Of Such Device

DECISION

This is in response to the correspondence addressed to the PCT Legal Office and filed on 06 September 2005.

BACKGROUND

This international application was filed on 18 November 2003, claimed an earlier priority date of 20 November 2002, and designated the United States. The International Bureau transmitted a copy of the published international application to the USPTO on 10 June 2004. The 30 month time period to pay the basic national fee in the U.S. expired as of midnight on 20 May 2005. On 30 December 2004, applicants filed *inter alia* the basic national fee.

On 13 July 2005, a Notice of Acceptance (Form PCT/DO/EO/903) was mailed to applicants, indicating that the date of this application under 35 U.S.C. 371(c)(1), (2) and (4) was "12/30/2004," and that the date of completion of all 35 U.S.C. 371 requirements was "05/20/2005."

DISCUSSION

Counsel indicates that the Notice of Acceptance mailed on 13 July 2005 was improper because "the above referenced application to enter the national stage in the U.S. was filed by express mail on December 9, 2004 without an inventors' declaration." Review of the record reveals that a declaration under PCT Rule 4.17(iv) was filed with the PCT Request (Form PCT/RO/101), and that said declaration was in compliance with 37 CFR 1.497(a) and (b). Therefore, said declaration satisfies 35 U.S.C. 371(c)(4). Although counsel refers to a filing by "Express Mail" on 09 December 2004, the application file does not currently include any evidence that correspondence was filed on that date. Instead, the record shows the correspondence directed to the U.S. national stage of this international application was first filed on 30 December 2004, and that all of the requirements of 35 U.S.C. 371(c)(1), (2) and (4) were present on that date. It is noted that the "date of completion of all 35 U.S.C. 371 requirements" was 20 May 2005 because applicants did not make an express request under 35 U.S.C. 371(f), so the national stage did not commence until 30 months had elapsed from the claimed priority date.

Counsel further requests that the \$360.00 multiple dependent claims fee be refunded because "it is applicant's intent to file a preliminary amendment which will eliminate all multiple

dependencies from the claims with the inventors' declaration upon receipt of the notice of missing requirements." However, review of the application file reveals that no such amendment appears to have actually been filed. Although 37 CFR 1.26 does provide that "The Director may refund any fee paid by mistake or in excess of that required," counsel has not demonstrated that the \$360.00 multiple dependent claims fee was in fact paid by mistake or was in excess of that required for the claim set which was presented. Therefore, it would not be appropriate to grant the refund request at this time.

DECISION

The request for issuance of a notification of missing requirements and the request for a fee refund are DISMISSED, without prejudice, as described above.

Any further correspondence regarding this matter should be addressed to the Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Richard Cole
PCT Legal Examiner
PCT Legal Office



George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3283
Fax: (571) 273-0459